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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,158	12/11/2000	Hidehiko Ogawa	MAT-8047US	4218

7590 08/15/2006

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EXAMINER

NALVEN, ANDREW L

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/734,158

Applicant(s)

OGAWA, HIDEHIKO

Examiner

Andrew L. Nalven

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 22-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

1. Claims 1 and 22-28 are pending.
2. Amendment submitted 2 June 2006 has been entered.

### ***Response to Arguments***

3. Applicant's arguments filed 2 June 2006 have been considered but are not persuasive.
4. Applicant has argued on page 7 that the Toyoda, Eguchi, and Firth references fail to teach a controller that...when the user designates email transmission on the panel, extracts from the memory a name corresponding to the password entered on the panel." Examiner respectfully disagrees. Toyoda teaches the designation of email transmission (Toyoda, column 20 lines 46-53) and Eguchi teaches the extraction from the memory a name corresponding to the password entered on the panel (Eguchi, column 7 line 65 – column 8 line 18, user enters code number, column 6 lines 52-64, header including sender appended when the email is sent) by teaching a user entering his code word which the system then uses to index into a table to access a user name. Thus, Examiner maintains that the combination of Toyoda and Eguchi teach the above cited limitation.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 22-28 are rejected under 35 U.S.C. 102(e) as being unpatentable over Toyoda et al US Patent No. 5,881,233 in view of Eguchi US Patent No 6,574,670, in view of Firth et al US Patent No 5,987,517, and in further view of Zhang et al US Patent No. 6,016,478.

7. With regards to claims 1 and 24, Toyoda teaches a scanner that scans an image to obtain image data (Toyoda, Figure 2), if email is designated, generating an email which includes or to which is attached inputted image data, said email including a designation that it is from said extracted name or email address (Toyoda, column 20 lines 46-53, column 21 lines 18-67, Figure 23 82A), if facsimile is designated, generating a facsimile based on said inputted image data (Toyoda, column 20 line 54 – column 21 line 6), if email is designated, transmitting the email so that the extracted name or the extracted email address is available to a recipient without opening said file (Toyoda, column 21 lines 18-67, Figure 23 82A, sender's email address is inherently available without opening attachment), and if facsimile is designated, transmitting the facsimile to the recipient (Toyoda, column 21 lines 7-18). Toyoda fails to teach the extracting of a name or an email address corresponding to an entered password or the

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extracting of a default name. Eguchi teaches a memory that stores for each of the users, user information including a password and a name (Eguchi, Figure 2A), panel where a user can enter a password (Eguchi, column 7 line 65 – column 8 line 18, user enters code number), extracting of a name or an email address corresponding to an entered password (Eguchi, column 7 line 65 – column 8 line 18, user enters code number, column 6 lines 52-64, header including sender appended when the email is sent). Firth teaches the extraction of default information or a default email address (Firth, column 17 lines 17-44). As Examiner noted above, the feature of making an email address available to a recipient without opening said file is an inherent feature of an email system because email addresses are separate from attachments and the addresses are displayed in an email inbox when an email is received. However, for the purposes of expedited prosecution Examiner is providing the Zhang reference as evidence of making an email address available to a recipient without opening (Zhang, Figure 12B, From address). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Eguchi's method of extracting names and address, Firth's method of sending default information, and Zhang's method of displaying extracted email addresses with Toyoda's facsimile apparatus because it offers the advantage of ensuring that an application program can provide all of the necessary functionality for a user by managing all details of the Internet application protocols including filling data structures and handling bad or incomplete data (Firth, column 1 line 66 – column 2 line 6), removing the need for a user to enter a long email

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address to identify the sender of an email (Eguchi, column 2 lines 18-34), and providing a mechanism for notifying a receiver of the sender of a message.

8. With regards to claims 22 and 25, Toyoda as modified teaches email being designated by inputting said recipients email address (Toyoda, column 21 lines 18-21).

9. With regards to claims 23 and 26, Toyoda as modified teaches facsimile designated by inputting said recipients telephone number (Toyoda, column 20 lines 54-59).

10. With regards to claims 27-28, Toyoda as modified teaches designating an email transmission (Toyoda, column 20 lines 46-53, column 21 lines 18-67, Figure 23 82A), designating facsimile transmission so that the default name is added to the image data (Toyoda, column 21 lines 7-18, column 20 line 54 – column 21 line 6), and entering said password (Eguchi, column 7 line 65 – column 8 line 18, user enters code number).

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Nalven whose telephone number is 571 272 3839. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

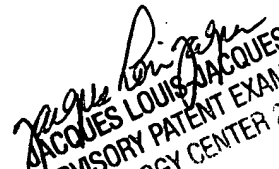
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on 571 272 6962. The fax phone

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number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Nalven



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